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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,106	08/22/2005	Rikki C Buckworth	AQUT100001000	1238

7590
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EXAMINER

HOEKSTRA, JEFFREY GERBEN

ART UNIT	PAPER NUMBER
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3736

MAIL DATE	DELIVERY MODE
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05/11/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/537,106	Applicant(s) BUCKWORTH ET AL.	
	Examiner Jeffrey G. Hoekstra	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 18-23 and 26-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/01/2005 and 04/15/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I drawn to claims 1-25 and Species A drawn to Figures 1-3 in the reply filed on 04/14/2009 is acknowledged. The traversal is on the ground(s) that the searching the method of Group II would necessarily require searching the apparatus of Group I. This is not found persuasive because the restriction was based upon the inventions lacking the same or corresponding special technical features under PCT Rules 13.1 and 13.2 (see paragraphs 1-2 mailed 03/31/2009).

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 18-23 and 26-28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 04/14/2009.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

5. The information disclosure statement(s) (IDS) submitted on 06/01/2005 and 04/15/2009 is/are acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97 and 1.98. Accordingly, the examiner is considering the information disclosure statement(s).

Specification

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-17, 24, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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9. Claim 1 positively recites the limitation "said tube bore" in line 4. There is insufficient antecedent basis for this limitation in the claim.

10. Claims 1-17, 24, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. The term "non-pliable" in claim 1 is a relative term which renders the claim indefinite. The term "non-pliable" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

12. Initially, the Examiner notes dependent claim 2 further defines the material comprising the "non-pliable" tube selected from the group consisting of metals, plastics, glass and ceramics.

13. Absent any special definition in the instant Specification upon which applicant does not appear to be relying, the term "non-pliable" is being given is broadest reasonable interpretation consistent with the plain meaning which may be plainly defined as "easily bent".

14. The scope of claim 1 is indeterminate with respect to how bendable (i.e. degree of bendability) and/or flexible the "non-pliable" material comprising the tub of the tip portion is. It is well known in the art that each material inherently has a flexibility or modulus of elasticity. The relative flexibilities of metals, plastics, glass and ceramics for

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example vary widely. metals, plastics, glass, and ceramics exist that may be either "easily bent" and/or "rigid".

15. As broadly as claimed the scope of claim 1 is indefinite.

16. For the purposes of examination on the merits and consistent with the instant Specification the claim is being treated on the merits such that the "tube of non-pliable material" has a first flexibility and the "bend [is] formed from a pliable material" has a second flexibility, wherein the first flexibility is less than the second flexibility, or the like.

17. Claims 1-17, 24, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

18. The term "optionally includes a plurality of barbs" in claim 1 is a relative term which renders the claim indefinite. The term "optionally" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

19. The scope of claim 1 is indeterminate with respect to whether the "plurality of barbs" is being structurally claimed or not and/or "when" or in what instance the "plurality of barbs" are "optionally" included.

20. For the purposes of examination on the merits and consistent with the instant Specification the claim is being treated on the merits such that the "plurality of barbs" are included.

21. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

22. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the relationship(s) between the “plurality of barbs” and the “at least one projecting member”.

23. The Examiner notes the claimed limitation the “plurality of barbs” necessitates more than one and at least two barbs. The scope of the claim is indeterminate with respect to how at least two barbs may comprise “at least one projecting member”.

24. For the purposes of examination on the merits and consistent with the instant Specification the claim is being treated on the merits such that the “plurality of barbs” comprises “at least two projecting members”.

Claim Rejections - 35 USC § 102

25. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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26. Claims 1-17, 24, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Rand, Jr. (US 4,543,742, hereinafter Rand).

27. For claim 1, Rand disclose a fish biopsy device (10), comprising *inter alia*:

- at least one hook (the left portion of 10 as best seen in Figure 1) (column 2) having a tip portion (the left-upper tip portion of 10 as best seen in Figure 1) (column 2),
- a bend (as best seen in Figure 1) (column 2), and
- a shank (around numeral 12 as best seen in Figure 1) (column 2),
- wherein said tip portion comprises a hollow tube of a first material having a first flexibility having a sharpened end (as best seen in Figure 1) (column 2),
- wherein said tube comprises a bore (as best seen in Figure 1) (column 2) therein and includes a plurality of barbs (60 and 62) disposed therein (as best seen in Figure 1A) (column 2),
- wherein said tube has an aperture therein distal said sharpened end (as best seen in Figure 1) (column 2), and
- wherein said bend is formed from a second material having a second flexibility greater than said first flexibility (as best seen in Figure 1) (column 2).

28. For claim 2, Rand disclose a fish biopsy device, wherein said tubular tip portion is capable of being fabricated from a material selected from the group consisting of metals, plastics, glass and ceramics.

29. For claim 3, Rand disclose a fish biopsy device, wherein said tubular tip portion is fabricated capable of being from stainless steel.

30. For claim 4, Rand disclose a fish biopsy device, wherein said sharpened end of the tip portion is capable of being provided by chamfering the edges of the tube forming the portion (as best seen in Figure 1).

31. For claim 5, Rand disclose a fish biopsy device, wherein said sharpened end of the tip portion is a bevel having an angle of 25 to 45 degrees to the axis of the tube forming the portion (as best seen in Figure 1).

32. For claim 6, Rand disclose a fish biopsy device, wherein said bevel has an angle of 30 degrees to the axis of the tube forming the portion (as best seen in Figure 1).

33. For claim 7, Rand disclose a fish biopsy device, wherein said tip portion is positioned so that the point formed by the bevel is on the outer side of the hook (as best seen in Figure 1).

34. For claim 8, Rand disclose a fish biopsy device, wherein said plurality of barbs are capable of being machined into the inside walls of the tube forming the tip portion.

35. For claim 9, Rand disclose a fish biopsy device, wherein said plurality of barbs comprises at least two members projecting into the bore of the tip portion from the end that adjoins the bend of the hook (as best seen in Figure 1A).

36. For claim 10, Rand disclose a fish biopsy device, wherein said at least one member comprises a dental broach (as best seen in Figure 1A).

37. For claim 11, Rand disclose a fish biopsy device, wherein said tip portion does not include internal barbs and the sharpened end has an internal diameter that is slightly less than the bore of the tip portion (as best seen in Figure 1).

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38. For claim 12, Rand disclose a fish biopsy device, wherein said aperture is a hole or slot cut through the wall of the tube forming the tip portion (as best seen in Figure 1).

39. For claim 13, Rand disclose a fish biopsy device, wherein said bend is capable of being fabricated from a material selected from the group consisting of plastics, ceramics, metals and alloys.

40. For claim 14, Rand disclose a fish biopsy device, wherein said bend is capable of being fabricated from copper.

41. For claim 15, Rand disclose a fish biopsy device, wherein said bend is capable of being fabricated from an aluminum alloy.

42. For claim 16, Rand disclose a fish biopsy device, wherein said bend is in the form of a tube (as best seen in Figure 1).

43. For claim 17, Rand disclose a fish biopsy device, wherein said bend and shank are formed from a single piece of material (as best seen in Figure 1).

44. For claim 24, Rand disclose a fish biopsy device, wherein said tip portion is threadingly engaged by said bend (as best seen in Figure 1).

45. For claim 25, Rand disclose a fish biopsy device, wherein said shank has an eye (24) (as best seen in Figure 1) at the end thereof for attachment of a line (22) to said device.

Conclusion

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46. The prior art made of record, cited in the accompanying PTO-892, and not relied upon is considered pertinent to applicant's disclosure. The cited prior art discloses and shows hollow tubular fish hook devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey G Hoekstra/
Examiner, Art Unit 3736

/Max Hindenburg/

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Supervisory Patent Examiner, Art Unit 3736